

Application No.: 09/867920

Docket No.: SMQ-052/P5699

**REMARKS**

Claims 1-24 are presently pending in the application of which claims 1, 12, 18 and 22 are independent. Claims 1, 12 and 22 have been amended.

**Claim Rejections Pursuant to 35 U.S.C. §103(a)**

Claims 1 and 3-10 were rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick (hereafter "Special Edition") in view of United States Patent No.: 6, 643, 694 to Chernin (hereafter "Chernin"). For the reasons set forth below, those rejections are respectfully traversed.

**Summary of Claimed Invention**

The claimed invention uses a search feature working with an email application to retrieve data from stored email messages. The search feature accepts a user-input search parameter. The search covers a current user-viewed storage location, and may also cover other email message storage locations as well. The search feature uses the parameter to retrieve data from email messages. The responsive data matching the search parameter is retrieved and a new document containing the responsive data is created.

**Summary of Claim Amendments**

Applicant has amended claim 22 to remove a typographical error. Applicant has amended claim 1 to clarify that the new document that is created contains the data that was retrieved from the messages (the email message that were searched) based on the user-input parameter. Applicant has amended claim 12 to add the limitation that the plurality of storage locations are on the electronic device upon which the email application is executing and that the electronic device is remotely located from the email server.

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Summary of Special Edition

The cited section of the Special Edition reference discusses finding and organizing OUTLOOK items. In response to user input search parameters, the Advanced Find feature displays search results to a user in a table format in the bottom of the search window. Searchable items include files, contacts, appointments, messages, notes and tasks. The search results point to the actual data indicated by the search. The search results may be double clicked by a user to display the item in the OUTLOOK form in which the item was originally created.

Summary of Chernin

Chernin discusses a system and method for integrating a proxy server, an e-mail server and a DHCP server with a graphic interface. The system includes numerous subsystems such as a subsystem which allows email searching via a graphic interface, a subsystem to provide Internet access monitoring via a graphic interface and a subsystem adapted to configure a DHCP server via a graphic user interface. The email searching subsystem allows the searching of email text. The system allows the user to enter a text string through the graphic interface to be searched. The search feature in the subsystem then searches through email archives on the mail server for the text string and displays the results to the user via the graphic interface.

Argument

The combination of Special Edition in view of Chernin fails to teach or suggest all of the elements of Applicant's independent claim 1 (and therefore also fails to teach or suggest all of the elements of claims 3-10 which are dependent thereon). Claim 1 as amended includes the step of "creating a new document containing the data that was retrieved from said messages based on the user-input parameter." Special Edition in view of Chernin fails to teach or suggest these limitations.

The limitation of claim 1 discussed above requires the retrieved data indicated by the user-input parameter to be contained in the created new document. Neither Special Edition nor Chernin teaches or suggests the inclusion of the data in the created new document. Rather,

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Special Edition presents results in a table in which entries may be selected in order to go to the original data item (see page 4-5 of Special Edition). Chernin presents a results page with hyperlinks to the original material (col. 35, lines 2-7). Neither reference thus presents the actual data in the created new document but rather presents the user with links which require an additional affirmative user selection in order to display the original data. Accordingly, neither reference teaches or suggests all of the claim limitations of claim 1 and Applicant therefore requests the allowance of claims 1 and 3-10.

Claim 2 was rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition in view of Chernin in further view of U.S. Patent Application Number 2003/0163468 (hereafter "Freeman"). For the reasons set forth below, this rejection is respectfully traversed.

The Examiner cited Freeman as teaching a document stream operating system that enabled the forwarding of the created document to a user of the electronic device (as required by claim 2). However, Freeman does not teach or suggest the "creating a new document containing the data that was retrieved from said messages based on the user-input parameter" limitation missing from the combination of Special Edition in view of Chernin that is required by the underlying claim 1. Accordingly, Applicants request the allowance of claim 2.

Claim 11 was rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition in view of Chernin in further view of U.S. Patent Number 6,243,501 (hereafter "Jamali"). For the reasons set forth below, this rejection is respectfully traversed.

Applicant respectfully submits that claim 11 is allowable for the same reason discussed above with reference to claim 1 as Jamali does not teach or suggest the limitation missing from the combination of Special Edition and Chernin. Additionally, Jamali does not teach the forwarding to a user of a created document containing the data indicated by the user-input parameter from which duplicative data has been deleted (as required by claim 11). Instead, Jamali deletes duplicative images from a storage space. For both reasons, Applicant requests the allowance of claim 11.

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Claims 12-13, 15-16 and 18-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 ("Special Edition") in view of United States Patent No.: 6,643,694 ("Chernin"), and further in view of U.S. Patent No.: 6,216,122 ("Elson"). Applicant respectfully traverses the rejection for the following reasons.

Applicant has amended claim 12 to indicate that the storage locations are located on the electronic device executing the email application and that the electronic device is remotely located from the email server. As Chernin clearly indicates that it is a server process and server archives that are being searched (col. 34, lines 59-64) it does not teach or suggest the search of the application side storage locations (storage locations on the electronic device executing the email application). Additionally, claim 12 includes the step of "inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document"[emphasis added]. As noted above, the combination of Special Edition in view of Chernin fails to disclose the creation of a new document that contains data from the search but rather discusses a results page with links to data responsive to the search. Elson also presents the user with "pointers to the e-mail messages that were found to match the search criteria" (Abstract) rather than the actual data responsive to the search term.

Claim 18 includes the step of "inserting the copied data from said selected email message into a new document." As outlined above, the combination of Special Edition, Chernin and Elson fails to disclose this limitation.

Accordingly as the combination of Special Edition in view of Chernin in further view of Elson fails to teach or suggest all of the elements of independent claims 12 and 18, Applicant requests the allowance of claims 12-13, 15-16 and 18-19.

Claims 14 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 ("Special Edition") in view of United States Patent No.: 6,643,694 ("Chernin"), and further in view of U.S. Patent No.: 6,216,122 ("Elson"), and further in view of U.S. Patent Application Publication No.: 2003/0131006 ("Monahan"). Applicant respectfully traverses the rejection for the following reasons.

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Claims 14 and 20 depend upon independent claims 12 and 18, respectively. Claims 14 and 20 include the additional limitation that the new document is in a Hypertext Markup Language (HTML) format. As set forth above, the combination of Special Edition in view of Chernin in further view of Elson fails to teach or suggest all of the limitations of independent claims 12 and 18. Mohanan is cited by the Examiner to provide teaching for the Hypertext Markup Language (HTML) format document but does not supply the missing limitations from the independent claims. Applicant also notes in passing that the need to combine four references to teach or suggest the limitations in Applicant's claims supplies an additional argument against obviousness. Accordingly, Applicant requests the allowance of claims 14 and 20.

Claims 17 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 ("Special Edition") in view of United States Patent No.: 6,643,694 ("Chernin"), and further in view of U.S. Patent No.: 6,216,122 ("Elson"), and further in view of U.S. Patent No.: 6,243,694 ("Jamali"). Applicant respectfully traverses the rejection for the following reasons.

Claims 17 and 21 depend upon claims 12 and 18, respectively. Claims 17 and 21 include the additional limitation that the new document is forwarded to a user after deleting email data that is duplicative. As set forth above, the combination of Special Edition in view of Chernin in further view of Elson fails to teach or suggest all of the limitations of independent claims 12 and 18. Jamali is cited by the Examiner to provide teaching for the deletion of duplicative data but does not supply the missing limitations from the independent claims. Applicant also refers the Examiner to the discussion of claim 11 above as to why Jamali fails to teach the additional limitation that the new document is forwarded to a user after deleting email data that is duplicative (a limitation that is found in claims 17 and 21). Accordingly, Applicant respectfully requests the allowance of claims 17 and 21.

Claims 22-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 ("Special Edition") in view of U.S. Patent No.: 6,216,122 ("Elson"), and further in view of U.S. Patent Application Publication No.: 2002/0138474 ("Lee"). Applicant respectfully traverses the rejection for the following reasons.

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Independent Claim 22 (upon which claim 23 is dependent) includes the step of "inserting the copied data from said selected email message into a new document." As noted above, the combination of Special Edition and Elson fail to teach or suggest the inserting of the copied data into a new document but rather generate a result page containing links to data. Lee is cited by the Examiner as disclosing the saving of search results, underlying documents and search criteria in local or remote memory units. Lee does not teach or suggest the creation of a new document into which to insert the copied data. Accordingly, Applicant requests the allowance of claims 22-23.

Claim 24 is rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 ("Special Edition") in view of U.S. Patent No.: 6,216,122 ("Elson"), and further in view of U.S. Patent Application Publication No.: 2002/0138474 ("Lee"), and further in view of U.S. Patent Application Publication No.: 2003/0002488 ("Hyakutake"). Claim 24 depends upon claim 22 and adds the limitation that the cached document is forwarded to a user. Applicant respectfully traverses the rejection for the following reasons.

As previously noted, the combination of Special Edition, Elson and Lee fail to teach or suggest the inserting of the copied data into a new document but rather generate a result page containing links to data. Hyakutake is cited by the Examiner as disclosing the forwarding of a cached document to a user. Hyakutake does not teach or suggest the creation of a new document into which to insert the copied data. Accordingly, Applicant requests the allowance of claim 24.

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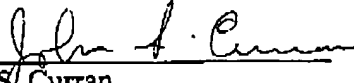
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CONCLUSION

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By   
John S. Curran  
Registration No.: 50,445  
LAHIVE & COCKFIELD, LLP  
28 State Street  
Boston, Massachusetts 02109  
(617) 227-7400  
(617) 742-4214 (Fax)  
Attorney/Agent For Applicant